

REMARKS

Claims 19-22, 26, 33-35 and 39-45 are pending in the instant application.

Reconsideration of the currently pending claims in light of the comments presented below is respectfully requested.

35 U.S.C. § 102(e)

Claims 19-31 and 33-40 stand rejected under 102(e) as anticipated by Kayyem et al., U.S. Patent No. 6,096,273 (“Kayyem”). In particular, the Examiner asserts that Kayyem teaches nucleic acids attached to electrodes via insulators, as is claimed in the instant application. In support of this assertion, the Examiner first points to Column 23, lines 23-65 which discusses passivation agents acting as a barrier between nucleic acids and an electrode. The Examiner then points out that passivation layers are described as being comprised of either conductive or insulating molecules. (Column 23, line 58). However, in contrast to the Examiner’s assertion, Applicant’s respectfully submit that this passage does not describe a nucleic acid attached to an electrode via an insulator.

The cited passage, read in the context of column 23 as a whole, describes a barrier that impedes the ability of a nucleic acid probes from coming in contact with the electrode, but is not actually attached to the nucleic acid probes. Applicants point to the paragraph immediately preceding the passage cited by the Examiner which clearly states, “arrays of different nucleic acids are laid down on the electrode, each of which are covalently attached to the electrode via a conductive linker.” That description is followed by the passage cited by the Examiner stating that “the electrode further comprises a passivation agent” and that the passivation agent “facilitates the maintenance of the nucleic acid away from the electrode surface.” (Column 23,

lines 35-36 and 40-41). At no point does the cited passage explicitly state that nucleic acids are attached to an electrode via a passivation agent, but rather the passivation agent only forms a barrier between the electrode and the nucleic acid. Accordingly, the Examiner has not shown that the passivation agent is the means of attaching a nucleic acid to an electrode, and therefore has not shown that an insulator is taught as the means for attaching a nucleic acid to an electrode.

For an anticipation rejection under 35 U.S.C. §102(e) to be proper, a single reference must expressly or inherently disclose each and every element of a claim. *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); MPEP § 2131 (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). As pointed out above, the Examiner has not pointed to any disclosure in Kayyem that teaches nucleic acids attached to electrodes via insulators. Accordingly, the Examiner has not carried her burden under §102(e), and therefore Applicants respectfully reiterate their request for withdrawal of the rejection.


CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and early notification to that effect is respectfully requested. Please direct any calls in connection with this application to the undersigned attorney at (415) 781-1989.

Respectfully submitted,

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